

FROM WILLKIE FARR 37 FAX DEPT  
Application Serial No. 09/647,279  
Attorney Docket No. 114474-13-FES100001  
Amendment Dated July 11, 2005  
Amendment and Response to Office Action

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7. (canceled)

8. (canceled)

9. (canceled)

10. (new) The plastic syringe barrel of claim 1, whercin the inner cylinder is made of cyclic polyolefin resin, and  
the outer peripheral surface of the inner cylinder has a sandblasted surface.

#### REMARKS/ARGUMENTS

Independent claim 1 is now pending, and is currently amended. Claim 1 stands rejected under 35 U.S.C. § 102. Dependent claims 3, 5, 7, 8 and 9 are also pending, and are now canceled. New dependent claim 10 has been added.

Claims 2 and 4 were previously canceled. Claim 6 was previously withdrawn from consideration when Applicant elected without traverse to prosecute the claims of Group 1, claims 1-5.

Applicant respectfully requests reconsideration of the application.

#### 1. Independent Claim 1

1. (currently amended) A plastic syringe barrel, comprising:

a nozzle portion in which an outer cylinder and an inner cylinder are formed, and  
a luer lock portion formed in the nozzle portion and between an inner peripheral  
surface of the outer cylinder and an outer peripheral surface of the inner cylinder,  
whrcin the outer cylinder is made of cyclic polyolefin resin,

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the inner peripheral surface of the outer cylinder contains a helically continuous screw thread, and

the surface of the screw thread and/or of a screw root portion formed between adjacent ridges of the screw thread have/has a sandblasted surface.

As was previously acknowledged, Moncada et al. fail to teach that the material of the syringe barrel (including the outer cylinder of the nozzle portion) is made of cyclic polyolefin resin (01/11/2005 Office action, at 5), and Moncada et al. fail to teach that the inner peripheral surface of the outer cylinder has a roughened surface. (01/11/2005 Office action, at 4.) Thus, Moncada et al. does not teach that the inner peripheral surface of the outer cylinder contains a helically continuous screw thread that has a sandblasted surface, or that a screw root portion formed between adjacent ridges of the screw thread has a sandblasted surface.

Further, the Office action identifies no teaching or suggestion in the prior art to modify Moncada et al. to form a sandblasted surface on the helical threads on the inner peripheral surface of the outer cylinder. The mere statement that such a modification of Moncada et al. "would have been obvious to one of the ordinary skill in the art at the time of the invention" is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine teachings of the prior art. (01/11/2005 Office action, at 4-5.) See M.P.E.P. § 2143.01.

Moreover, the teeth of Moncada et al. markedly increase the frictional force necessary to engage an extension tube or the like with the luer lock portion, and therefore may result in breakage of the outer cylinder made of cyclic polyolefin resin. The sandblasted surface of claim 1 allows for smooth engagement but with sufficient coefficient of friction to also firmly

hold the extension tube in place. A sandblasted surface is also more appropriate than teeth to modify the syringe portions made of cyclic polyolefin resin – a stiff material that is easily broken.

The Office action also states that Porfano et al. teach that a syringe barrel is made of cyclic polyolefin copolymer resin. (01/11/2005 Office action, at 5.) But there is no teaching or suggestion in the art to combine Moncada et al. – an adapter for mounting a needle guard on a syringe – with Porfano et al., which discloses methods and apparatus for maintaining a locally controlled, clean environment for various operations in assembly of medical devices. (Col. 2, lines 6-12) The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See MPEP § 2143.03.

With regard to the remarks concerning the recitation “formed by blast treatment” in previously rejected claims 1, 5 and 7, the 01/11/2005 Office action states that “the method of forming the syringe barrel is not germane to the issue of patentability of the syringe barrel itself.” (01/11/2005 Office action, at 2-3.) However, neither the 01/11/2005 nor the 04/26/2005 Office action cites any legal authority for discounting a portion of claim language.

In short, amended claim 1 is not anticipated, taught, or suggested by the prior art of record.

## II. Dependent Claim 10

10. (new) The plastic syringe barrel of claim 1, wherein the inner cylinder is made of cyclic polyolefin resin, and

the outer peripheral surface of the inner cylinder has a sandblasted surface.

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New dependent claim 10 recites features that further distinguish the art and is patentable with independent claim 1. New dependent claim 10 provides that the inner cylinder of the nozzle is made of cyclic polyolefin resin and that the outer peripheral surface of the inner cylinder has a sandblasted surface.

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance, and requests that the application be approved for issuance.

Enclosed herewith is a Request for Continued Examination (RCE) transmittal (2 copies) and a Petition for Extension of Time for five (5) months. Kindly charge all fees, any credit or surplus, to Deposit Account No. 23-2405, Order No. 114474.00013.

Respectfully submitted,

WILLKIE FARR & GALLAGHER, LLP

Dated: July 11, 2005

By:

  
Leslie M. Spencer  
Registration No. 47,105

WILLKIE FARR & GALLAGHER, LLP  
787 Seventh Ave.  
New York, New York 10019  
212-728-8782  
212-728-9782 Fax  
lspencer@willkie.com